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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,192	08/09/2001	Dan W. Denney JR.	GENITOPE-06493	5113
7590 10/05/2004 MEDLEN & CARROLL, LLP Suite 350 101 Howard Street San Francisco, CA 94105			EXAMINER YAEN, CHRISTOPHER H	
			ART UNIT 1642	PAPER NUMBER

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/925,192	Applicant(s) DENNEY, DAN W.	
	Examiner Christopher H Yaen	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 25-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>9/30/2004</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Re: Denney DW

Priority Date: May 1, 1998

1. Upon further review, the restriction requirement made on 8/24/2004 is vacated in favor of a new restriction requirement set forth herein.
2. Claims 1-24 are canceled without prejudice.
3. Claims 25-39 are newly added and pending.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 25-29, drawn to a method of co-amplifying recombinant oligonucleotides comprising the steps of providing 2 vectors comprising recombinant oligonucleotides and a T-lymphoid cell line; introducing said vectors into said cell line; introducing the cell line into an aqueous solution, and identifying a cell capable of growth in said solution, classified in class 435, subclass 69.2, for example.
 - II. Claims 30-34, drawn to a method of co-amplifying recombinant oligonucleotides comprising the steps of providing 3 vectors comprising recombinant oligonucleotides and a T-lymphoid cell line; introducing said vectors into said cell line; introducing the cell line into a first aqueous solution; identifying a cell capable of growth in said first solution;

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introducing said cells into a second solution; and identifying a cell capable of growth in said second solution, classified in class 435, subclass 69.7.

- III. Claims 35-39, drawn to a method of producing a vaccine for treatment of B-cell Lymphoma comprising the steps of providing a malignant cell isolated from a B-cell lymphoma, a amplification vector comprising an oligonucleotides, and a T-cell lymphoid parental cell line; isolating from malignant cell nucleotide sequences; inserting said nucleotide sequences from malignant cell into a first and second expression vector; introducing said first vector and second expression vectors into said parental cell line to generate a transformed cell; introducing the transformed cell into a first aqueous solution; and identifying a transformed cell capable of growth in first aqueous solution, classified in class 435, subclass 69.3.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

The instant specification does not disclose that these methods would be used together.

The methods of groups I-III are all unrelated as they comprise distinct steps and utilize different products which demonstrates that each method has a different mode of operation. For example, the invention of group I comprises the use of 2 vectors while that of group II comprises the use of three type of vectors. Both groups I-II are drawn to methods of co-amplification, while the method of group III is drawn to a method of

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producing a vaccine. Each invention performs the function using structurally and functionally divergent material. Moreover, the methodology and materials necessary for the inventions of group I and II differ significantly for each of the materials. While the purpose of the methods of groups I-II and III differ in outcome and desired use. Therefore, each method is divergent in materials and steps. For these reasons the Inventions I-III are patentably distinct.

Furthermore, the distinct steps and products require separate and distinct searches. The inventions of Groups I-III have a separate status in the art as shown by their different classifications. As such, it would be burdensome to search the inventions of Groups IV, V and VI together.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen
Art Unit 1642
September 30, 2004


GARY NICKOL
PRIMARY EXAMINER